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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,089	10/31/2003	Dirk Stenkamp	1/1407	1853
28501	7590	09/29/2006	EXAMINER	
MICHAEL P. MORRIS BOEHRINGER INGELHEIM CORPORATION 900 RIDGEBURY ROAD P. O. BOX 368 RIDGEFIELD, CT 06877-0368			POWERS, FIONA	
			ART UNIT	PAPER NUMBER
			1626	
DATE MAILED: 09/29/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,089

Applicant(s)

STENKAMP ET AL.

Examiner

Fiona T. Powers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 14 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/26/04, 5/31/06</u> | 6) <input type="checkbox"/> Other: _____ |

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Receipt is acknowledged of the information disclosure statements filed March 26, 2004 and May 31, 2006, which have been entered in the file.

Applicant's election with traverse of Group I, claims 1 to 18 in the reply filed on July 13, 2006 is acknowledged. The traversal is on the ground(s) that Groups I and II are sufficiently related such that the search for relevant art for one Group would be expected to uncover prior art that is relevant to the other Group since each of these Groups involves the same compounds. This is not found persuasive because each of the Groups is separately classified therefore a search for prior art for one Group would not necessarily uncover prior art for the other Group. Furthermore, Group II involves compounds that are excluded from Group I.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1 to 4, 8 to 13, 15 and 18 are rejected under 35 U.S.C. 102(a) as being anticipated by Fahmy et al. (Chemical Abstracts, 137:109242, 2002), cited.

The reference discloses the claimed compounds of the formula I and composition thereof wherein R^1 , R^2 and R^3 are hydrogen; X is C_1 alkylene that has been replaced by SO_2 ; Y and A are phenyl; Z is a single bond; W is CH_2O and b is 0. Note Registry Nos. 442908-87-4 and 442908-89-6.

Claims 1 to 4, 8 to 13, 15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Ariesan et al. (Chemical Abstracts, 84:116338, 1976) or Khlaponina et al. (Chemical Abstracts, 108:68297, 1988) or Zheng et al. (Chemical Abstracts 113:77848, 1990), cited.

The references disclose the claimed compounds of the formula I and composition thereof wherein R^1 and R^3 are hydrogen; R^2 is hydrogen, substituted alkyl or cycloalkyl; X is C_1 alkylene that has been replaced by SO_2 ; Y and A are phenyl; Z is a single bond or alkylene; W is CH_2O and b is 0. Note Registry Nos. 25196-37-6, 58590-27-5, 58590-29-7, 58590-34-4 and 5850-36-6 of Ariesan et al.; Registry No. 12557-26-3 of Khlaponia et al.; and Registry Nos. 128720-87-6 and 128720-88-7 of Zheng et al.

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Claims 1 to 4, 6 to 13, 15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Baker et al. (Chemical Abstracts, 69:64778, 1968), cited.

The reference discloses the claimed compound of the formula I and composition thereof wherein R^1 , R^2 and R^3 are hydrogen; X is CH_2 ; Y and A are phenyl; Z is a single bond; W is CH_2O and b is 0. Note Registry No. 18705-07-2.

Claims 1 to 5, 8 to 13, 15, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Koppe et al. (US 4948812), cited.

The reference discloses the claimed compounds of the formula I, salts and compositions thereof wherein R^1 and R^2 are alkyl or R^1 and R^2 together with N form a heterocyclic ring; R^3 is hydrogen; X is $CH_2CH(OH)CH_2O$; Y and A are phenyl; Z is a single bond; W is CH_2O and b is 0. Note Examples 1-13, 21-23, 28-43, 51, 52, 54-56, 59-61 and 74-80.

Claims 1 to 13, 15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmitt et al. (US 3551478) or Metz et al. (US 4146637) or Metz et al. (US 4294851), cited.

The references disclose the claimed compounds of the formula I and compositions thereof wherein R^1 and R^2 are alkyl or R^1 and R^2 together with N form a heterocyclic ring; R^3 is

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hydrogen; X is alkylene where two CH_2 have been replaced by O or NH and C=O ; Y and A are phenyl; Z is a single bond; W is $\text{CR}^{6a}\text{R}^{6b}\text{-O}$, $\text{CR}^{6a}\text{R}^{6b}\text{-N}$, where R^{6a} and R^{6b} are H or alkyl; and b is 0. Note Compound Nos. 1-59 of Table II of Schmitt et al.; Examples 6-9, 11, 40-58, 61, 62, 64-69, 71 and 74-76 of Table I of Metz et al. (US 4146637); and Examples 1-4, 7-11, 13-34, 36-53, 79-83 and 87-92 of Metz et al. (US 4294851).

Claims 14 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The references made of record and not relied upon show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday -, Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fiona T. Powers

Fiona T. Powers
Primary Examiner
Art Unit 1626

ftp
September 22, 2006